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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/733,467

12/12/2003

Veronique Ferrari

244818US0

8836

22850

7590

12/30/2009

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.  
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ALEXANDRIA, VA 22314

EXAMINER

VENKAT, JYOTHSNA A

ART UNIT

PAPER NUMBER

1619

NOTIFICATION DATE

DELIVERY MODE

12/30/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/733,467	<b>Applicant(s)</b> FERRARI ET AL.	
	<b>Examiner</b> JYOTHSNA A. VENKAT	<b>Art Unit</b> 1619	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 74, 75, 78-79, 81, 83, 85, 87-88, 90-91, 93-94, 96, 98-99, 102-103, 105, 107, 109, 111-112, 114-115, 117-118, 120, 122-123, 125-127, 129, 131, 133, 135-139, 141-142, 144 and 146-166 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

Continuation of Disposition of Claims: Claims pending in the application are  
74,75,78,79,81,83,85,87,88,90,91,93,94,96,98,99,102,103,105,107,109,111,112,114,115,117,118,120,122,123,125-  
127,129,131,133,135-139,141,142,144 and 146-166.

Art Unit: 1619

### **DETAILED ACTION**

Receipt is acknowledged of amendment and remarks filed on 10/9/09. Claims 161-166 have been added as per applicants' amendment dated 10/9/09.

#### **Status of claims**

**Claims 1-73, 76, 80, 82, 84, 86,89, 92, 95, 97, 100-101, 104, 106, 108, 110, 113, 116, 119, 121, 124-125, 128, 130, 132, 134,137, 140, 143, and 145 are cancelled.** Claims 74, 75, 78-79, 81, 83, 85, 87-88, 90-91, 93-94, 96, 98-99,102-103,105,107, 109,111-112, 114-115, 117-118, 120, 122-123, 125-127, 129,131,133,135-139, 141-142,144 and 146-166 are currently pending.

#### ***Claim Rejections - 35 USC § 103***

Claims 74, 75, 78-79, 81, 83, 85, 87-88, 90-91, 93-94, 96, 98-99,102-103,105,107, 109,111-112, 114-115, 117-118, 120, 122-123, 125-127, 129,131,133,135-139, 141-142,144 and 146-160 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U. S. Patent 5,837, 223 ('223) and WO 03/013,447 ('447).

Patent '223 teaches transfer resistant high luster cosmetic compositions and teaches at col.2, line 25 through col.3, line 17 claimed volatile solvent, which is isododecane and teaches claimed siloxy silicate polymer (claimed silicone film forming agent,) at col.3, line 57 through col.4, line 17 and teaches at col.1, ll 11-17 pigments compositions for coloring the skin and lips and teaches under examples lipstick compositions. Patent at col.6, ll 13-22 teaches pigments and under examples teaches anhydrous lipsticks. The difference between the patent and the instant application is patent '223 does not teach claimed silicone polyamide copolymer.

However WO '447 teaches the claimed silicone copolymer in cosmetic compositions. See formula A at page 3, see page 4, for DP, see paragraph [0014] for weight percent of silicone

Art Unit: 1619

polyamide, see paragraphs [0015-0016] and [0019] for fatty phase, see paragraph [0032] for various formulations, see paragraph [0043] for waxes and see paragraph [0044] for claimed crystalline silicone compound, see paragraph [0046] for claimed pigments, see all the examples.

Accordingly it would be obvious to one of ordinary skill in the art at the time the invention was made to prepare transfer resistant compositions of patent '223 and add the silicone polyamide copolymer of WO document and use this polymer in various cosmetic formulations with the reasonable expectation of success that the silicone polyamide copolymers can be formulated into various cosmetic products and **these cosmetic products are also transfer resistant in view of the silicone polyamide copolymers taught by WO '447 at page 2, [0006].**

This is a prima facie case of obviousness.

### ***Response to Arguments***

Applicant's arguments filed 10/9/09 have been fully considered but they are not persuasive.

Applicants' argue:

*“The pending claims require the presence of both a silicone-polyamide copolymer and a silicone film forming resin (particularly MQ resin or trimethyl siloxysilicate) in a composition. The applied art would not lead one of ordinary skill in the art to such liquid compositions. Barone discloses stick compositions (see, col. 1, line 59; abstract). Thus, Barone teaches away from liquid compositions. Moreover, one of ordinary skill in the art would not have been motivated to modify Barone's compositions to make them liquid in direct contravention to Barone's teachings. PCT*

Art Unit: 1619

*'447's disclosure would not motivate one to ignore Barone's teachings.*

*Stated another way, one of ordinary skill in the art, following Barone, would prepare a solid composition, not a liquid composition, regardless of PCT '447's disclosure. Thus, the applied art would not lead one of ordinary skill in the art to the claimed compositions or methods”.*

In response to the above argument, patent at col.2, ll 6-9 teaches:

The term “stick” refers to cosmetic compositions having a consistency such that they can be molded into the form of a stick—for instance by being heated until molten and then poured into a mold and cooled.

Thus patent implicitly teaches “liquid” compositions since the expression “molten” implies liquid. Note that the stick compositions are obtained when the composition is molten and it poured into a mold and cooled. Patent ‘223 teaches transfer resistant cosmetic compositions using the claimed siloxy silicate polymer.

WO document teaches the claimed silicone polyamide copolymer in various formulations and teaches at page 9:

Art Unit: 1619

[0030] The hair and skin care compositions according to the present invention can easily be manufactured by methods known to those skilled in the art. Typically, the compositions can be made by mixing the various components at an elevated temperature (that is, by heating and mixing the various components) and then cooling in order to form a thickened composition such as a cream or lotion. For cosmetic compositions, additional ingredients can be added using techniques and manufacturing processes known in the art. Typically, any volatile components (such as fragrances) are added to the mixture at a relatively late stage of the mixing, so as to limit volatilization of the volatile components.

[0031] The siloxane-based polyamide can be dissolved in a silicone fluid, for example, at elevated temperatures (for example, up to 160 degrees C.) so as to form a solution. It is preferred that the solution is not heated too long or at too high a temperature, so as not to cause the solution to color. The hair or skin care active can be added to the solution of silicone fluid and silicone-polyamide copolymer and mixed to homogeneity. For example, the silicone fluids, other organic solvents and siloxane-based polyamides can be mixed at elevated temperatures so as to dissolve the polymer in the silicone fluid, with cosmetically active ingredients being added to the mixture of silicone fluid and polymer. In the case where an aqueous phase is included, an emulsion is the result. Alternately, as when formulating a solid cosmetic such as a lipstick, the siloxane-based polyamide can be heated above its melting point and added to a hot lipstick base with appropriate mixing. Where the product is a cream product, the molten product, at elevated temperatures, can be poured into dispensing containers and allowed to cool and thicken therein.

[0032] The siloxane-based polyamides can be formulated into a wide variety of product types, including mousses, gels, lotions, creams, tonics, sprays, shampoos, sunscreens, anti-acne preparations, topical analgesics, mascaras, lipsticks, color foundations, and the like.

Thus WO '447 explicitly teaches cosmetic compositions having the claimed silicone polyamide copolymer in the form of liquids like shampoos and hair tonic (see paragraph [0032]) and also lipsticks and teaches at paragraph [0031] line 26 that aqueous phase can be added and this results in emulsions ( liquids), thickened compositions like r lotions at paragraph[0030]. Lotions are liquid compositions.

Art Unit: 1619

A reference is analyzed using its broadest teachings. MPEP 2123 [R-5]. "[W]hen a patent simply arranges old elements with each performing the same function it had been known to perform and yields no more than one would expect from such an arrangement, the combination is obvious". *KSR v. Teleflex*, 127 S.Ct. 1727, 1740 (2007)(quoting *Sakraida v. A.G. Pro*, 425 U.S. 273, 282 (1976)). "[W]hen the question is whether a patent claiming the combination of elements of prior art is obvious", the relevant question is "whether the improvement is more than the predictable use of prior art elements according to their established functions." (*Id*). Addressing the issue of obviousness, the Supreme Court noted that the analysis under 35 USC 103 "need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *KSR v. Teleflex*, 127 S.Ct. 1727, 1741 (2007). The Court emphasized that **"[a] person of ordinary skill is... a person of ordinary creativity, not an automaton."** *Id* at 1742.

Therefore one of ordinary skill in the cosmetic art would prepare transfer resistant compositions of patent '223 and add the silicone polyamide copolymer of WO document and use this polymer in various cosmetic formulations taught by WO document with the reasonable expectation of success that the silicone polyamide copolymers can be formulated into various cosmetic products and these cosmetic products are also transfer resistant in view of the silicone polyamide copolymers taught by WO '447 at page 2, [0006]. Enhanced transfer resistant property is obtained in view of siloxy silicate of patent and silicone polyamide copolymer of WO '447 ( emphasis added).



Art Unit: 1619

Applicants' did not submit any data that claimed **liquid compositions** having siloxy silicate and claimed silicone polyamide copolymer **exhibit unexpected and superior results** over solid lipstick compositions using the same silicone polyamide copolymer and siloxy silicate.

In conclusion the claims are prima facie obvious over the combination of references cited above within the meaning of 35 U. S. C. 103.

### ***Double Patenting***

Claims 74, 75, 78-79, 81, 83, 85, 87-88, 90-91, 93-94, 96, 98-99, 102-103, 105, 107, 109, 111-112, 114-115, 117-118, 120, 122-123, 125-127, 129, 131, 133, 135-139, 141-142, 144 and 146-153 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-25 of U.S. Patent No. 6,958,155 in view of U. S. Patent 5,837, 223 ('223).

Both the instant application and patent are claiming the same silicone polyamide copolymer in transfer resistant cosmetic compositions. Patent '155 is not claiming the claimed silicone resin as the film forming agent. Patent '223 teaches transfer resistant high luster cosmetic compositions and teaches at col.2, line 25 through col.3, line 17 claimed volatile solvent, which is isododecane and teaches claimed siloxy silicate polymer (claimed silicone film forming agent,) at col.3, line 57 through col.4, line 17 and teaches at col.1, ll 11-17 pigments compositions for coloring the skin and lips and teaches under examples lipstick compositions. Patent at col.6, ll 13-22 teaches pigments.

Accordingly it would be obvious to use the transfer resistant compositions of patent '155 and add the silicone film forming resin and volatile oil of patent '223.

Art Unit: 1619

It is prima facie obvious to combine two known compositions that have been used individually as transfer resistant with the reasonable expectation of success that the third composition also would be transfer resistant.

### ***Response to Arguments***

Applicant's arguments filed 10/9/09 have been fully considered but they are not persuasive.

Applicants' argue that Barone discloses solid compositions, so nothing in Barone would teach or suggest preparing a liquid composition. For at least this reason Barone cannot compensate for the identified deficiencies of the claims of the '155 patent, and the combination of the '155 claims and Barone would not lead to the claimed methods or compositions.

In response to the above argument, patent at col.2, ll 6-9 teaches:

The term "stick" refers to cosmetic compositions having a consistency such that they can be molded into the form of a stick—for instance by being heated until molten and then poured into a mold and cooled.

Thus patent implicitly teaches "liquid" compositions since the expression "molten" implies liquid. Therefore one of ordinary skill in the cosmetic art would prepare transfer resistant compositions of patent '155 and add the silicone film forming resin and volatile oil of patent '223 because it is prima facie obvious to combine two known compositions that have been used individually as transfer resistant with the reasonable expectation of success that the third composition claimed also would be transfer resistant.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 1619

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, EYLER YVONNE (BONNIE) can be reached on 571-272-0871. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1619

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JYOTHSNA A VENKAT /  
Primary Examiner, Art Unit 1619